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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,183	08/31/2004	Timothy Ray Poe	2901288-000002	5182

49840 7590 05/09/2007
BAKER, DONELSON, BEARMAN, CALDWELL & BERKOWITZ
SUITE 3100 SIX CONCOURSE PARKWAY
ATLANTA, GA 30328

EXAMINER

CULBERT, ROBERTS P

ART UNIT	PAPER NUMBER
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1763

MAIL DATE	DELIVERY MODE
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05/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/711,183	Applicant(s) POE, TIMOTHY RAY	
	Examiner Roberts Culbert	Art Unit 1763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 8-10, drawn to a composition, classified in class 252, subclass 79.1.
- II. Claims 11-14, drawn to a method for etching an electroplated surface, classified in class 216, subclass 24.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the process for using the product as claimed can be practiced with another materially different product such as muriatic acid. Further, the product as claimed can be used in a materially different process of using that product such as a fertilizer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, and the extensive search required for Group I is not required for Group II, and a search for both inventions would place an undue burden on the examiner, restriction for examination purposes as indicated is proper

During a telephone conversation with Thomas A. Hodge on 4/11/07 a provisional election was made with traverse to prosecute the invention of Group I, claims 8-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Note: The composition recited in the claims is simply a solution of potassium sulfate (sulfated potash) having a ratio of one teaspoon or one tablespoon to one gallon water. Aqueous potassium sulfate has long been used in various concentrations as an analytical reagent, and in cleaners, fertilizers and other aqueous compositions with and without other components. Thus, the numerous prior art documents that anticipate and/ or obviate the claimed invention have not been cited by the examiner.

Claims 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,367,903 to Gladney et al.

Regarding Claim 8, Gladney et al. teaches a composition comprising sulfated potash and water.

Note that the limitations “for tarnishing an electroplated non-reflective surface of a mirror” are not given patentable weight, since they read on an intended use of the composition and do not materially affect the claimed composition.

Note that “*If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999).*” See MPEP 2111.02.

Regarding Claim 10, Gladney et al. teach the ratio of one tablespoon sulfated potash in one gallon water.

Note that in for conversion:

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$$1 \text{ tbs/gal} = 5.625 \text{ g/L} = 0.5625 \text{ parts/100 parts water by weight}$$

Since:

$$1 \text{ gal} = 3.785 \text{ L}$$

$$1 \text{ tbs} = 14.78676 \text{ cm}^3 = 21.3\text{g}$$

$$\text{Bulk Density of Potassium Sulfate} = 1.44 \text{ g/cm}^3$$

Claims 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by SU 1604769A to Barg et al.

Regarding Claim 8, Barg et al. teaches a composition comprising sulfated potash and water.

Note that the limitations "for tarnishing an electroplated non-reflective surface of a mirror" are not given patentable weight, since they read on an intended use of the composition and do not materially affect the claimed composition.

Regarding Claim 9, Barg et al. substantially teaches the ratio of one teaspoon sulfated potash to one gallon water.

Note that in for conversion:

$$1\text{tsp/gal} = 1.875 \text{ g/L} = 0.1875 \text{ wt \%}$$

Since:

$$1 \text{ gal} = 3.785 \text{ L}$$

$$1 \text{ tsp} = 4.928922 \text{ cm}^3 = 7.1\text{g}$$

$$\text{Bulk Density of Potassium Sulfate} = 1.44 \text{ g/cm}^3$$

Regarding Claim 10, Barg et al. teach the ratio of one tablespoon sulfated potash in one gallon water.

Note that in for conversion:

$$1 \text{ tbs/gal} = 5.625 \text{ g/L} = 0.5625 \text{ wt\%}$$

Since:

$$1 \text{ gal} = 3.785 \text{ L}$$

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$$1 \text{ tbs} = 14.78676 \text{ cm}^3 = 21.3\text{g}$$


$$\text{Bulk Density of Potassium Sulfate} = 1.44 \text{ g/cm}^3$$

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberts Culbert whose telephone number is (571) 272-1433. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on (571) 272-1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


R. Culbert
Examiner
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